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Brief  
10-15-02  
C. Moore

D-1116R1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	)	
<b>J. Richard Hanna, et al.</b>	)	
Serial No.: <b>09/408,858</b>	)	Art Unit 2876
Confirm. No.: <b>4536</b>	)	
Filed: <b>September 30, 1999</b>	)	Patent Examiner
	)	Jared J. Fureman
Title: <b>Automated Merchant Banking</b>	)	
<b>Apparatus and Method</b>	)	

Board of Patent Appeals and Interferences  
Commissioner for Patents  
Washington, D.C. 20231

**BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.192**

Sir:

The Appellants hereby submit their Brief pursuant to 37 C.F.R. § 1.192, in triplicate,  
concerning the above-referenced Application.

**REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is  
Diebold, Incorporated, an Ohio corporation.

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## **RELATED APPEALS AND INTERFERENCES**

Appellants believe that there are no related appeals or interferences pertaining to this matter.

## **STATUS OF CLAIMS**

Claims 1-30 are pending in the Application.

Claims 1, 3, 8, 11, 21-24, and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Peters et al. ("Peters").

Claims 22-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by Johnston.

Claims 2, 4, 12, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Cataldo et al ("Cataldo").

Claims 5-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Graef et al ("Graef").

Claims 9-10, 13, 15, 17, 20, 26, and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Henry et al ("Henry").

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Blumstein et al ("Blumstein").

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters as modified by Henry as applied to claim 15, and further in view of Cataldo.

Claims 18-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Abecassis.

Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Tranchita et al ("Tranchita").

These rejections were the only rejections present in the Office Action ("Action") dated June 26, 2002, which was made Final. Appellants appeal the rejections of the claims, inclusive.

### **STATUS OF AMENDMENTS**

A final rejection was made June 26, 2002. No amendments to the claims were requested to be admitted after the final rejection.

### **SUMMARY OF INVENTION**

#### Overview of the Invention

An exemplary form of the invention is directed to an apparatus and a method of providing a depositor with assurance that a deposit accepting machine, such as an ATM, has recorded the fact that they made the deposit. The machine can include an item accepting depository (54) for accepting items for deposit, such as currency. A depositor may input data associated with the deposit item, such as an amount or a depository bag ID number, to be received by the machine. An image of the deposited item inside the machine can be captured with an interior imaging device, such as a camera (326). An image of the depositor can also be captured with an exterior

imaging device, such as a camera (58). The inputted data, deposit item image, and depositor image can be stored in a memory storage device, such as in a single combined image. The inputted data, deposit item image, and depositor image can also be simultaneously displayed through a machine display (20), as shown for example in Figure 50.

Figures 26 and 28 show an exemplary form of the deposit accepting machine operative to accept deposits. An exterior camera (58) can capture an image of the user. A door (56) is movable to an open position to enable a user to access an interior area of the machine through an open access opening (57). A rotating pocket assembly (318) can serve as an item transport for a deposit item. The assembly (318) includes a first pocket (320) and a second pocket (322). After a user inserts an item to be deposited into the adjacent pocket, the assembly (318) can be rotated. This rotation causes the deposit item to be transported away from the access opening so that it can no longer be accessed again by the user. That is, the deposit item becomes a deposited item. The deposited item can be passed by gravity out of the pocket and into a throat area (324). The throat area (324) includes a camera (326) therein. The camera (326) can serve as an interior imaging device which has a field of view including the interior area of the machine. The camera (326) can capture an image of the deposited item. The camera (326) may be an infrared camera which is capable of delivering images of deposited items in near total darkness conditions which may exist in the internal area of the machine in the vicinity of the throat area. The deposited item can continue into a secure chest (62). Further description related to an exemplary form of the invention may be found, for example, at Specification page 57, line 16 to page 63, line 8.

## CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The questions presented in this appeal are:

- 1). Whether Appellants' claims 1, 3, 8, 11, 21-24, and 27 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Peters.
- 2). Whether Appellants' claims 22-23 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Johnston.
- 3). Whether Appellants' claims 2, 4, 12, and 25 are unpatentable under 35 U.S.C. § 103(a) over Peters in view of Cataldo.
- 4). Whether Appellants' claims 5-7 are unpatentable under 35 U.S.C. § 103(a) over Peters in view of Graef.
- 5). Whether Appellants' claims 9-10, 13, 15, 17, 20, 26, and 29-30 are unpatentable under 35 U.S.C. § 103(a) over Peters in view of Henry.
- 6). Whether Appellants' claim 14 is unpatentable under 35 U.S.C. § 103(a) over Peters in view of Blumstein.
- 7). Whether Appellants' claim 16 is unpatentable under 35 U.S.C. § 103(a) over Peters as modified by Henry as applied to claim 15, and further in view of Cataldo.
- 8). Whether Appellants' claims 18-19 are unpatentable under 35 U.S.C. § 103(a) over Peters in view of Abecassis.
- 9). Whether Appellants' claim 28 is unpatentable under 35 U.S.C. § 103(a) over Peters in view of Tranchita.

## GROUPING OF CLAIMS

No groups of claims stand or fall together. Every claim recites additional features of the invention which distinguishes the claim over every other pending claim.

Each of Appellants' claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

The pending claims include three independent claims (claims 1, 22, and 29). Claims 2-21 depend from claim 1. Claims 23-28 depend from claim 22. Claim 30 depends from claim 29.

All pending claims 1-30 are reproduced in the Appendix.

## ARGUMENT

### The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To

establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

#### **The Peters Reference**

Phillips is directed to an ATM capable of loading a receipt or a mini statement to a flex disc (34). Other information may also be loaded to the flex disc, such as an image of a scanned document (e.g., check) and an image of the user. The flex disc can be used on a home computer in association with a spreadsheet of the users bank account.

#### **The Johnston Reference**

Johnston is directed to a depository apparatus for envelopes and documents. The apparatus includes an envelope transport section (35) and a document transport section (36). The document transport section (36) includes scanning means (76). An image of a deposit document is displayed on a screen (24) prior to its deposit. After displaying the document, the document can then be returned to the user. Otherwise, with user confirmation to deposit the displayed document, the document can later be "eventually deposited" in a bin module (86) (col. 6, line 64 to col. 7, line 10; col. 5, lines 33-60).



### **The Cataldo Reference**

Cataldo is directed to a bank deposit identification device. A dual lens camera can be operated to photograph the depositor and deposit package. The dual camera may be a movie camera to record the operation from the opening of the chute door to the closing thereof.

### **The Graef Reference**

Graef is directed to an article depositing apparatus. A transport belt (370) conveys a document deposit over an image scanner (80). An image of the downward facing side of the document deposit is obtained and conveyed to a CPU of the ATM (col. 20, lines 13-21).

### **The Henry Reference**

Henry is directed to a programmable electronic lock. A display screen (28) is used by the electronic lock (12) to communicate with a user (col. 5, lines 52-53). The lock is configured with a keypad (22) to allow a user to input data into the lock (col. 5, lines 36-37). Security may be increased through a dual validation process of key and PIN code entry (col. 3, lines 6-8).

### **The Blumstein Reference**

Blumstein is directed to a customer activated terminal for visually impaired. Blumstein teaches a method of entering numerical information. For each digit of a multidigit number a first touch screen location is touched a number of times equal to the digit followed by touching a second location. Once all the digits have been entered, a third location is touched.

### **The Abecassis Reference**

Abecassis is directed to a deposit authorization system. A deposit is tendered for the purchase of goods. The system permits a purchase deposit slip to exclude card information, provide for a delivery date, and utilize a transaction number. The transaction number both identifies the deposit transaction and represents an approval number.

### **The Tranchita Reference**

Tranchita is directed to auxiliary illumination of a surveillance area. The external surveillance field of view for a camera may be illuminated using an infrared laser.

### **(iii) 35 U.S.C. § 102**

#### **The Pending Claims Are Not Anticipated By Peters**

In the Action claims 1, 3, 8, 11, 21-24, and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Peters. The Appellants respectfully disagree with the Action's interpretation of Peters.

Peters does not teach each and every step, feature, and relationship of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections.

Peters does not explicitly or inherently teach the recited method. Inherency may not be established based on probabilities or possibilities. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a

cited reference. It is improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999). The Appellants respectfully submit that the Office has not proved that the recited features lacking in Peters are "necessarily present."

Furthermore, the Action's assertions are not based on any evidence in the record. The evidence of record must teach the recited features. An assertion of knowledge not based on any evidence in the record lacks substantial evidence support. Rather, the Office must point to some concrete evidence in the record. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

No factual evidence has been presented that Peters explicitly teaches the recited features or that the recited features are "necessarily present" in Peters. Peters does not anticipate the recited method claims. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejections should be withdrawn.

### **Claim 1**

Peters does not teach the recited steps, features, and relationships. The Action alleges that Peters teaches a deposit accepting machine (ATM 10). However, Peters does not teach "displaying the user image and the item image to the user through a display operatively connected to the deposit accepting machine" (i.e., step (c)). Nor does Peters teach "capturing an item image of a deposit item placed inside the deposit accepting machine with an interior area imaging device, wherein the interior area imaging device has a field of view including an interior area inside the deposit accepting machine" (i.e., step (b)). Thus, Peters cannot anticipate claim 1.

Peters does not teach step (c)

Peters does not explicitly or inherently teach using a display (operatively connected to a deposit accepting machine) for displaying a captured user image and a captured item image to a user. There is no evidence that Peters' ATM display screen (14) is even capable of displaying a user image and an item image to a user. Contrarily, Peters teaches that the image data is written to the disc (34). Peters only teaches that the disc's image data is displayed on a modified home PC (50), not through a display in the manner recited.

Furthermore, there is no evidence that Peters has the hardware and software arrangements necessary to permit the ATM display screen (14) to display a user image and an item image to a user, especially when the images would have to be retrieved from the disc. Where does Peters teach having the necessary software to display images captured by external and interior area imaging devices? Peters does not teach displaying both a user image and an item image either before or after information is written to the disc (34).

There is no evidence that Peters has the memory necessary for reading the disc, especially when the disc contains a large file (col. 2, lines 27-34). Nor is there any evidence that Peters' ATM is able to decompress disc data (col. 2, lines 30-34). Additionally, there is no evidence that Peters' ATM is able to read encrypted data which was written to the disc by the ATM. That is, Peters' ATM may be arranged to provide encrypted data to the disc without the capability to reread the data as a security precaution. Such an arrangement would prevent an unauthorized user from accessing personal account information from a lost or stolen disc by using the ATM to read the disc. Additionally, Peters desires to reduce space within the ATM (col. 1, lines 11-12;

col. 2, lines 23-25). Thus, Peters teaches away from having the additional hardware and software features necessary to permit the ATM display screen (14) to display a user image and an item image to a user. Thus, Peters cannot anticipate the claim.

The Office incorrectly associates Peters' verification with image display. Peters does not teach verifying information written to the disc by displaying images on the display screen (14). Nor has the Office proved that displaying a user image and an item image on Peters' display screen (14) is "necessarily present" in Peters. Nor are the Action's allegations based on any evidence in the record. *In re Zurko*, supra. Where is Peters limited to displaying the images on the display screen (14) for verification? Appellants respectfully submit that it is well known to "verify" disc data in other manners, such as without opening a disc file. For example, typically the name, size, type, and date of a file on a disc (e.g., floppy disk) can be verified without opening the file. That is, a disc can be opened to verify its contents without requiring opening of the files thereon. There is no teaching whatsoever in Peters that the "verifying" requires opening an image file and displaying the image on the display screen (14).

Furthermore, Peters suggests that the disc data can be verified while compressed (col. 2, lines 30-34). This would further indicate that the image file is not opened when the disc information is verified. It follows that a user image and an item image are not displayed on Peters' display screen (14). Again, the opening and displaying of an image file is not "necessarily present" or required in Peters. Thus, inherency has not been established. *In re Robertson*, supra.

There is also no evidence that the disc reader/writer (28) is capable of reading an image file. Peters only teaches that the reader/writer is capable of reading a user's written (text)

transaction data, which corresponds to keypad input data (e.g., numeric data) (col. 2, lines 35-40). Thus, if Peters' reader/writer can't read an image file from the disc, then it follows that the disc image file can't be opened and displayed. It follows that Peters' disc image file can't be opened and displayed for verification.

Peters also indicates that the disc data is used on a home computer in association with a spreadsheet of the user's bank account (col. 2, lines 19-20). That is, it appears that additional spreadsheet software is needed to use the disc data. There is no evidence that Peters' ATM includes the necessary spreadsheet software to open and display the disc data in readable form. Nor is there any evidence that Peters' ATM has the user's own personal spreadsheet of the user's bank account, especially a spreadsheet which may have personal settings. It follows that Peters would not open the disc files for display in verification.

Nevertheless, even if it were somehow possible (which it isn't) for Peters to verify disc information by displaying images on the display screen (14), it would still be improper to reject claim 1 under 35 U.S.C. § 102 based merely on the possibility that Peters could or might be used or operated in the manner recited in the claim. *In re Robertson*, supra.

Peters does not teach step (b)

Peters does not explicitly or inherently teach that an item image is captured with an interior area imaging device, especially where the interior area imaging device has a field of view of an interior area inside a deposit accepting machine.

Peters refers to "a digital image of a scanned document such as a cheque or a bill payment form from the document processing module 40" (col. 2, lines 53-55). However, there is no

evidence that the document is scanned inside of Peters' ATM. Where does Peters explicitly teach that the document (e.g., check) is scanned inside of the machine? Where is Peters limited to having the document scanned inside of the machine? The use of hand scanners was well known prior to the filing date of Peters. There is no teaching in Peters that prevents the document from being scanned outside of the ATM, such as by the user. It follows that capturing an image of a deposit item with an interior area imaging device (having an interior area field of view) is not "necessarily present" or required in Peters. Thus, inherency has not been established. *In re Robertson, supra*. There is no teaching in Peters of "capturing an item image of a deposit item placed inside the deposit accepting machine."

Nevertheless, even if it were somehow possible for the document scanner to be inside of Peters' ATM, it would still be improper to reject claim 1 under 35 U.S.C. § 102 based merely on the possibility that Peters could or might be used or operated in the manner recited in the claim. *In re Robertson, supra*.

Furthermore, even if it were somehow possible for the document scanner to be inside of Peters' ATM, Appellants question whether such a scanner would have a "field of view" of "an interior area inside" of Peters' ATM.

Additionally, the Action (page 6, lines 9 and 13-14) admits the Peters fails to teach that "the image of the deposit item in step (b) is captured when the deposit item is in the first internal area." That is, by inference the Action admits that Peters does not teach "capturing an item image of a deposit item placed inside the deposit accepting machine" (i.e., step (b)). It follows that Peters cannot anticipate step (b).

Peters does not teach the recited steps. It follows that Peters cannot anticipate claim 1. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejection should be withdrawn.

### **Claim 3**

Claim 1 has been previously shown to be allowable. It is asserted that claim 3, which depends from claim 1, is allowable on the same basis. Claim 3 also recites a storing step that further patentably distinguishes the claimed invention over Peters.

### **Claim 8**

Peters does not teach "enabling the user to access the interior area to place the deposit item therein." Where does Peters teach permitting a user to access an interior area inside the ATM, especially to place a deposit item therein? Peters does not anticipate claim 8.

Also, even if it were somehow possible for a document scanner to be inside of Peters' ATM, there is no teaching that a user would be able to access the scanner's "field of view" of "an interior area inside" (claim 1) the ATM. That is, why would a user in Peters have access to an interiorly located scanner when an exteriorly located scanner would be more convenient? This supplements Appellants' previous (claim 1) argument that the scanner can be outside of Peters' ATM.

### **Claim 11**

Claim 11 depends from claim 8. Peters also does not teach an input device and input received in the manner recited.

### **Claim 21**

Peters does not teach an apparatus including the deposit accepting machine, external area imaging device, internal area imaging device, and display recited in claim 1. Nor does Peters



teach that the apparatus can be operated responsive to a computer to perform the method steps recited in claim 1. It follows that Peters cannot anticipate claim 21.

### **Claim 22**

Claim 22 recites some subject matter similar to subject matter in claim 1. Appellants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. Thus, it is respectfully submitted that claim 22 also patentably distinguishes over Peters.

Peters does not teach depositing an item inside a deposit accepting machine, and displaying an image of the deposited item through a display operatively connected to the deposit accepting machine. It follows that Peters does not teach that a depositor is provided assurance of the deposit.

In an exemplary form of the invention an image of the deposited item is displayed to provide the user assurance that the deposit accepting device has recorded the fact that they made the deposit (e.g., Specification page 6, lines 15-17; page 62, lines 2-3).

Peters does not provide deposit assurance. As previously discussed, Peters does not explicitly or inherently teach using a display (operatively connected to a deposit accepting machine) for displaying an image of a deposit item. Furthermore, even if it were somehow possible (which it isn't) for Peters to display an image of a deposit item on the display screen (14), there is still no teaching that the image would be that of a deposited item. Claim 22 recites displaying an image of a deposited item. Where does Peters specifically teach that the scanning is that of a "deposited" document? In an exemplary form of the invention the deposit item can no

longer be accessed or retrieved again by the user, wherein the deposit item becomes a deposited item. What teaching in Peters prevents a user from retrieving the scanned document? For example, the prior art (e.g., Johnston at col. 6, line 64 to col. 7, line 10) teaches that a deposit item can be returned to the user after obtaining an image of the deposit item. If a deposit item can be returned then it was never "deposited." This indicates that the scanning of a "deposited" item is not "necessarily present" in Peters. It would not be proper to reject claim 22 under 35 U.S.C. § 102 based merely on the possibility that Peters could or might be used or operated in the manner recited in the claim. *In re Robertson*, supra. Appellants have previously presented reasons why Peters does not teach displaying an image of a deposit item. Appellants have also shown why Peters does not teach displaying the image of a "deposited" item. It follows that Peters does not teach that a depositor is provided assurance of the deposit. It further follows that Peters does not anticipate claim 22.

### **Claim 23**

Peters does not teach "capturing an item image of the deposited item inside the deposit accepting machine with an imaging device." Peters does not explicitly or inherently teach capturing an image of an item inside a deposit accepting machine nor capturing an image of a deposited item. It follows that Peters cannot teach displaying an image of a deposited item through a display operatively connected to the deposit accepting machine. Nor can Peters anticipate claim 23.

#### **Claim 24**

Claim 24 depends from claim 23. As previously discussed, Peters does not teach displaying both an image of a deposited item and a depositor image through a display. It follows that Peters cannot anticipate claim 24.

#### **Claim 27**

Claim 27 depends from claim 24. As previously discussed, Peters does not teach capturing an item image of a deposited item inside the deposit accepting machine with an imaging device and capturing a depositor image of a depositor with an imaging device. Nor does Peters teach that an item image capturing device has a field of view including a machine interior area, and that a depositor image capturing device has a field of view including an exterior area. Thus, Peters does not anticipate claim 27.

#### **The Pending Claims Are Not Anticipated By Johnston**

In the Action claims 22-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by Johnston. The Appellants respectfully disagree with the Action's interpretation of Johnston.

The Action alleges that Johnston teaches a deposit accepting machine (10), a display (24), and an item imaging device (scanning means 76).

Johnston does not teach each and every step, feature, and relationship of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections. Johnston does not anticipate the recited method claims. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejections should be withdrawn.

## **Claim 22**

Johnston does not teach depositing an item inside a deposit accepting machine, and displaying an image of the deposited item through a display operatively connected to the deposit accepting machine. It follows that Johnston does not teach that a depositor is provided assurance of the deposit.

As previously discussed, in an exemplary form of the invention an image of the deposited item is displayed to provide the user assurance that the deposit accepting device has recorded the fact that they made the deposit (e.g., Specification page 6, lines 15-17; page 62, lines 2-3).

Johnston teaches (e.g., col. 6, line 64 to col. 7, line 10; col. 5, lines 33-60) that the deposit item can be returned to the user after displaying an image of the deposit item. Johnston also admits that the displayed document can later be "eventually deposited" (col. 7, line 3). In Johnston an image of the item is first displayed, then the user needs to confirm (col. 5, lines 52 and 55; col. 6, line 67) whether the item should be deposited. If the user does not confirm, then the item is returned to the user. The Appellants respectfully submit that if Johnston's displayed item can be returned then it was never "deposited." That is, Johnston does not teach displaying an image of a deposited item. Contrarily, Johnston specifically teaches displaying an image of a document prior to that document being deposited. In Johnston's operational sequence the item can only be deposited following the displaying of the item. In Johnston's chain of events the depositing occurs after the displaying. Johnston, at best, only displays an image (e.g., a pre-deposit image) of an item which may or may not be later "eventually deposited."

Johnston does not display an image of a deposited item. It follows that Johnston does not teach that "a depositor is provided assurance of the deposit." It further follows that Johnston cannot anticipate claim 22.

#### **Claim 23**

Johnston does not teach "capturing an item image of the deposited item inside the deposit accepting machine with an imaging device." Where does Johnston teach capturing an image of a deposited item? Contrarily, Johnston specifically teaches capturing an image of a document prior to the document being deposited. It follows that Johnston cannot anticipate claim 23.

#### **(iv) 35 U.S.C. § 103**

The attempts to combine the teachings of the references are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure. It follows that it would not have been obvious to have modified the references in the manner alleged. Furthermore, without a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01).

Appellants traverse the rejections on the grounds that Appellants' claims recite steps, features, and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The

steps, features, and relationships recited in Appellants' claims patentably distinguish over the applied references. Nor would it have been obvious to one having ordinary skill in the art to have combined the teachings of the references to have produced the recited invention.

The Office does not factually support any *prima facie* conclusion of obviousness. If the Office does not produce a *prima facie* case, which is the current situation, then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142). Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections are improper and should be withdrawn.

**The Pending Claims Are Not Obvious Over  
Peters in view of Cataldo**

Claims 2, 4, 12, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Cataldo. These rejections are respectfully traversed.

Appellants' remarks involving Peters in support of the patentability of claims 1 and 22 are incorporated by reference as if fully rewritten herein.

**Claim 2**

Neither Peters nor Cataldo teach or suggest simultaneously displaying a user image and an item image to a user through a display operatively connected to a deposit accepting machine.

The Action (page 4, last paragraph) admits that Peters "fails to specifically teach that the user image and the item image are simultaneously displayed through the display." Cataldo cannot alleviate the deficiencies in Peters in regard to the recited features. Cataldo teaches use of

film. However, there is no teaching or suggestion that Cataldo's film is capable of being displayed through a display. Nor is there any teaching or suggestion that Cataldo's depository even has a display. Even the Action (page 5, line 8) acknowledges that Cataldo lacks a display. Nor is there any teaching or suggestion that Cataldo's film is capable of being displayed through a display operatively connected to Cataldo's depository (11). Nor is there any teaching or suggestion that Cataldo simultaneously displays a user image and an item image to a user of the depository. Cataldo's film appears to be only for the bank's usage. It follows that Cataldo does not teach or suggest simultaneously displaying a user image and an item image to a user through a display operatively connected to a deposit accepting machine.

Nor is there any teaching or suggestion that Peters' display is capable of displaying Cataldo's film therethrough. Peters is associated with a "digital" image not with film.

Furthermore, as previously discussed (claim 1), there isn't any teaching or suggestion that Peters' display is even capable of displaying images. Peters does not teach or suggest using a display (operatively connected to a deposit accepting machine) for displaying a captured user image and a captured item image to a user. There is no teaching or suggestion that Peters' display screen (14) is capable of displaying a user image and an item image to a user, especially simultaneously displayed images.

It would not have been obvious to one having ordinary skill in the art to have even considered displaying Cataldo's film through Peters' display. Any attempt to modify Peters with the teaching of Cataldo would destroy the disclosed and desired utility and operability of the Peters teaching. An obviousness rejection cannot be based on a combination of features in

references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Neither Peters nor Cataldo, taken alone or in combination, disclose or suggest the recited steps. Nor would it have been obvious to have combined the references to have produced the recited invention. Additionally, even if it were somehow possible to combine the references (which it isn't) the resultant combination would not have been obvious because the prior art does not suggest the desirability of the combination (MPEP § 2143.01).

The Action has not presented any factual evidence that it was known in the prior art to simultaneously display a user image and an item image to a user through a display operatively connected to a deposit accepting machine. Thus, the Office has not presented a *prima facie* showing of obviousness.

#### **Claim 4**

The Action (page 4, last paragraph) admits that Peters fails to teach that a user image is captured responsive to the user moving a door to a position opening an access opening. Peters neither teaches nor suggests a movable door selectively enabling access to an interior area through an access opening. It follows that a user in Peters would not have been able to move a door in the manner recited. It further follows that it would not have been obvious to have captured a user image in Peters responsive to the user moving a door to a position opening an access opening.

Cataldo cannot alleviate the deficiencies in Peters in regard to the recited features. Nor does the Action explain how Peters could be modified with the teachings of Cataldo to produce



the recited invention. Since the Action does not explain the rejections with reasonable specificity it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). Neither Peters nor Cataldo, taken alone or in combination, disclose or suggest the recited steps. The Office has not established a *prima facie* showing of obviousness.

#### **Claim 12**

Claim 12 depends from claim 2. The Action (page 4, last paragraph) admits that Peters fails to teach that a user image and an item image are displayed as a single combined image, and further comprising the step of storing the single combined image in a storage device.

Cataldo cannot alleviate the deficiencies in Peters in regard to the recited features. As previously discussed, Cataldo does not display a user image and an item image to a user through a display operatively connected to a deposit accepting machine. It follows that neither Peters nor Cataldo, taken alone or in combination, disclose or suggest displaying a user image and an item image as a single combined image. The Office has not established a *prima facie* showing of obviousness.

#### **Claim 25**

Claim 25 depends from claim 24. The Action (page 4, last paragraph) admits that Peters "fails to specifically teach that the user image and the item image are simultaneously displayed through the display."

Cataldo cannot alleviate the deficiencies in Peters in regard to the recited features. Note Appellants' remarks regarding claim 2.

Neither Peters nor Cataldo, taken alone or in combination, disclose or suggest simultaneously displaying a depositor image and an item image through a display in the manner recited. The Office has not established a *prima facie* showing of obviousness.

**The Pending Claims Are Not Obvious Over  
Peters in view of Graef**

Claims 5-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Graef. These rejections are respectfully traversed.

Appellants' remarks involving Peters in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein.

**Claim 5**

The Action (page 6, lines 9-14) admits that Peters fails to teach "moving the deposit item away from the access opening with the item transport to a first internal area wherein the deposit is not accessible through the access opening, and wherein the image of the deposit item in step (b) is captured when the deposit item is in the first internal area."

Graef cannot alleviate the deficiencies in Peters in regard to the recited features. Nor does the Action explain how Peters could be modified with the teachings of Graef to produce the recited invention. Since the Action does not explain the rejections with reasonable specificity it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, supra. Neither Peters nor Graef, taken alone or in combination, disclose or suggest the recited steps. The Office has not established a *prima facie* showing of obviousness.

### **Claim 6**

Claim 6 depends from claim 5. The Action (page 6, lines 14-17) admits that Peters fails to teach that "the interior area of the deposit accepting machine further includes a second internal area, wherein the deposit item is stored in the interior area in the second internal area, and subsequent to step (c) further comprising the step of passing the deposit item from the first internal area to the second internal area."

Graef cannot alleviate the deficiencies in Peters in regard to the recited features. The Appellants respectfully disagree with the Action's interpretation of Graef. For example, the Action alleges that Graef teaches "displaying the item image to a user though a display (not shown)." However, it appears that in Graef only select fields of information from the digital image data can be displayed to a user (col. 24, lines 63-65). For example, Graef teaches that "in a check cashing procedure, the field showing the amount of the check is preferably displayed" (col. 24, lines 66-67). That is, Graef teaches displaying only the amount of the check. Graef does not teach displaying the item image (i.e., check image) to a user, as alleged.

Neither Peters nor Graef, taken alone or in combination, disclose or suggest the recited steps. The Office has not established a *prima facie* showing of obviousness.

### **Claim 7**

Claim 7 depends from claim 3. The Action (page 6, lines 18-19) admits that Peters fails to teach that a "storage device is in operative connection with a server, and further comprising the step of accessing the item image from a remote computer through the server."

Neither Peters nor Graef, taken alone or in combination, teach or suggest displaying both a user image and an item image (claim 1), nor storing the user image and the item image in associated relation in a storage device (claim 3), nor accessing at least one of the item image and the user image from a remote computer through the server (claim 7). Where does either reference teach or suggest accessing an image (which was also displayed) from a remote computer through a server? As previously discussed (e.g., claim 6), Graef does not teach or suggest displaying an image (i.e., check image) to a user. Nor does Peters teach or suggest displaying an image in the manner recited. It follows that the Office has not established a *prima facie* showing of obviousness.

**The Pending Claims Are Not Obvious Over  
Peters in view of Henry**

Claims 9-10, 13, 15, 17, 20, 26, and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Henry. These rejections are respectfully traversed.

Appellants' remarks involving Peters in support of the patentability of claims 1 and 22 are incorporated by reference as if fully rewritten herein. Henry does not teach or suggest displaying a user image or an item image. Henry is non analogous art.

**Claim 9**

Claim 9 depends from claim 8. The Action (page 9, second paragraph) admits that Peters fails to teach that a "user input received includes a deposit bag identifier." As previously discussed (claim 8), Peters does not teach permitting a user to access an interior area inside the

machine, especially to place a deposit item therein. That is, Peters is not capable of receiving a deposit item such as a deposit bag. Thus, it would not have been obvious to one having ordinary skill in the art to have attempted to modify Peters to permit receiving a user input of a deposit bag identifier. It follows that the Office has not established a *prima facie* showing of obviousness.

#### **Claim 10**

Claim 10 depends from claim 8. Henry cannot alleviate the deficiencies in Peters in regard to the recited features. Note Appellants' remarks regarding claim 9.

#### **Claim 13**

Claim 13 depends from claim 8. The Action (page 9, second paragraph) admits that Peters fails to teach that "user input further including amount data representative of an amount associated with the deposit item, and wherein the amount is displayed through the display with the user image and the item image."

As previously discussed (claim 1), Peters does not teach or suggest displaying both a user image and an item image. Henry does not teach or suggest displaying a user image or an item image. Henry is non analogous art. It follows that neither Peters nor Henry, taken alone or in combination, teach or suggest displaying amount data (representative of an amount associated with a deposit item) through a display with a user image and an item image. Nor has the Office established a *prima facie* showing of obviousness.

### **Claim 15**

Claim 15 depends from claim 13. The Action (page 9, second paragraph) admits that Peters fails to teach amount data displayed through a display with a user image and an item image. Neither Peters nor Henry associate amount, user image, and item image in the manner recited. As previously discussed (claim 13), neither Peters nor Henry, taken alone or in combination, teach or suggest displaying amount data through a display with a user image and an item image. It follows that neither Peters nor Henry, taken alone or in combination, teach or suggest storing data representative of the amount, user image, and item image in associated relation in a storage device. Thus, it would not have been obvious to have combined the references to have produced the recited invention.

### **Claim 17**

Claim 17 depends from claim 15. As previously discussed (claim 15), neither Peters nor Henry, taken alone or in combination, teach or suggest storing data representative of an amount, user image, and item image in associated relation in a storage device. It follows that neither Peters nor Henry, taken alone or in combination, teach or suggest storing data representative of recorded time, an amount, user image, and item image in associated relation in a storage device. Furthermore, as previously discussed, Henry is non analogous art. The Office has not established a *prima facie* showing of obviousness.

### **Claim 20**

Claim 20 depends from claim 17. As previously discussed (claim 17), neither Peters nor Henry, taken alone or in combination, teach or suggest storing data representative of recorded

time, an amount, user image, and item image in associated relation in a storage device. It follows that neither Peters nor Henry, taken alone or in combination, teach or suggest accessing with a remote computer through a server the associated stored data representative of the recorded time, amount, user image and item image. Again, the Office has not established a *prima facie* showing of obviousness.

#### **Claim 26**

Claim 26 depends from claim 25. Neither Peters nor Henry, taken alone or in combination, teach or suggest simultaneously displaying input data, a depositor image, and an item image through a display.

The Action (page 4, last paragraph) admits that Peters "fails to specifically teach that the user image and the item image are simultaneously displayed through the display" (claim 25). It follows that Peters cannot teach or suggest simultaneously displaying input data, a depositor image, and an item image through a display (claim 26).

Henry cannot alleviate the deficiencies in Peters in regard to the recited features. Henry does not teach or suggest displaying a user image or an item image. Henry is non analogous art. It follows that Henry cannot teach or suggest simultaneously displaying input data, a depositor image, and an item image through a display.

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Office bears the burden of establishing that all the recited features of the claim are known in the prior art. The Appellants respectfully submit that the Office has not met this burden. The Office does not factually support any *prima facie* conclusion of obviousness.

Furthermore, claim 26 depends from claim 25. It is noted that the Action relies upon Cataldo for the rejection of claim 25. However, the rejection of claim 26 does not include Cataldo. By inference, the Office admits that the rejection of claim 26 is lacking.

### **Claim 29**

Appellants' remarks in support of the patentability of claims 1, 13, and 22 are incorporated by reference as if fully rewritten herein. Neither Peters nor Henry, taken alone or in combination, teach or suggest displaying depositor input data (associated with a deposit item), a depositor image, and an image of a deposited item through a display operatively connected to a deposit accepting machine.

As previously discussed (claim 1), Peters does not teach or suggest displaying both a user image and a deposit item image. As previously discussed (claim 22), Peters does not teach or suggest displaying an image of a deposited item. The Action (page 9, second paragraph) admits that Peters fails to teach that depositor input data (and user image and item image) is displayed through a display. It follows that Peters does not teach or suggest "displaying the data, a depositor image, and an image of the deposited item through a display operatively connected to the deposit accepting machine."

Henry cannot alleviate the deficiencies in Peters in regard to the recited features. Henry is non analogous art. Henry does not teach or suggest displaying a user image or an item image. It follows that Henry does not teach or suggest displaying both a user image and an item image. Nor does Henry teach or suggest displaying an image of a deposited item. It further follows that



Henry cannot teach or suggest "displaying the data, a depositor image, and an image of the deposited item through a display operatively connected to the deposit accepting machine."

It follows that neither Peters nor Henry, taken alone or in combination, teach or suggest displaying depositor input data (associated with a deposit item), a depositor image, and an image of a deposited item through a display operatively connected to a deposit accepting machine. Nor has the Office established a *prima facie* showing of obviousness.

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Office bears the burden of establishing that all the recited features of the claim are known in the prior art. The Appellants respectfully submit that the Office has not met this burden. The Office does not factually support any *prima facie* conclusion of obviousness. It would not have been obvious to have combined the references to have produced the recited invention.

### **Claim 30**

Claim 30 depends from claim 29. The Action (page 4, last paragraph) admits that Peters "fails to specifically teach that the user image and the item image are simultaneously displayed through the display." It follows that Peters cannot teach or suggest simultaneously displaying depositor input data, a depositor image, and an item image through a display.

Henry cannot alleviate the deficiencies in Peters in regard to the recited features. Henry does not teach or suggest displaying a user image or an item image. Henry is non analogous art. It follows that Henry cannot teach or suggest simultaneously displaying depositor input data, a depositor image, and an item image through a display.

Neither Peters nor Henry, taken alone or in combination, teach or suggest simultaneously displaying depositor input data, a depositor image, and an item image through a display

operatively connected to a deposit accepting machine. The Office has not established a *prima facie* showing of obviousness.

**The Pending Claims Are Not Obvious Over  
Peters in view of Blumstein**

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Blumstein. The rejection is respectfully traversed.

Appellants' remarks involving Peters in support of the patentability of claims 1 and 8 are incorporated by reference as if fully rewritten herein.

**Claim 14**

Claim 14 depends from claim 8. The Action (page 11, first paragraph) admits that Peters fails to teach that a user input includes data representative of a first amount of a first type item included in a deposit item and a second amount of a second type item included in the deposit item, and wherein the first amount and the second amount are displayed with a user image and an item image. The Action (page 9, second paragraph) also admits that Peters fails to teach amount data displayed through a display with a user image and an item image.

The Action relies on Blumstein for the recited features. However, Blumstein cannot alleviate the deficiencies in Peters in regard to the recited features. Blumstein is non analogous art. Blumstein does not teach or suggest displaying a user image or an item image. It follows that Blumstein does not teach or suggest displaying both a user image and an item image. It

further follows that Blumstein cannot teach or suggest that a first amount and a second amount are displayed with a user image and an item image.

Neither Peters nor Blumstein, taken alone or in combination, teach or suggest displaying a first amount and a second amount with a user image and an item image to a user through a display operatively connected to a deposit accepting machine. The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to have combined the references to have produced the recited invention.

**The Pending Claims Are Not Obvious Over  
Peters as modified by Henry (as applied to claim 15)  
and further in view of Cataldo**

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters as modified by Henry as applied to claim 15, and further in view of Cataldo. The rejection is respectfully traversed.

Appellants' remarks involving Peters and Henry in support of the patentability of claims 1, 8, 13, and 15 are incorporated by reference as if fully rewritten herein.

**Claim 16**

Claim 16 depends from claim 15. The Action (page 11, last paragraph) admits that Peters as modified by Henry fails to teach that an amount, user image, and item image are stored as a single combined image in a storage device.

The Action relies on Cataldo for the recited features. However, Cataldo cannot alleviate the deficiencies in Peters as modified by Henry in regard to the recited features.

Cataldo does not teach or suggest storing data representative of an amount associated with a deposit item in a storage device. It follows that Cataldo does not teach or suggest storing an amount associated with a deposit item, a user image, and an item image as a single combined image in a storage device.

Neither Peters, Henry, nor Cataldo, taken alone or in combination, teach or suggest storing an amount associated with a deposit item, a user image, and an item image as a single combined image in a storage device. The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to have combined the references to have produced the recited invention.

**The Pending Claims Are Not Obvious Over  
Peters in view of Abecassis**

Claims 18-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Abecassis. These rejections are respectfully traversed.

Appellants' remarks involving Peters in support of the patentability of claims 1 and 8 are incorporated by reference as if fully rewritten herein.

**Claim 18**

Claim 18 depends from claim 8. The Action (page 12) admits that Peters fails to teach presenting on a display a prompt message for a user to input a receipt number corresponding to a number of receipts to be provided; receiving from a user a receipt number input through an input device operatively connected to the deposit accepting machine; and providing with a receipt

delivery device operatively connected to the deposit accepting machine a number of receipts corresponding to the receipt number input by the user. The Action (page 13, lines 16-17) further admits that Peters fails to teach inputting a receipt number corresponding to a number of receipts to be provided.

Abecassis cannot alleviate the admitted deficiencies in Peters. In Abecassis a single transaction slip can have two sections, an (upper) merchant section and a (lower) customer section (col. 9, lines 29-66). Where does Abecassis permit the number of receipts to be selected? Where does Abecassis permit a user to select the number of receipts to be provided?

Abecassis does not teach or suggest presenting on a display a prompt message for a user (customer) to input a receipt number corresponding to a number of receipts to be provided. Nor does Abecassis teach or suggest receiving from a user a receipt number input through an input device operatively connected to the deposit accepting machine. Nor does Abecassis teach or suggest providing with a receipt delivery device operatively connected to a deposit accepting machine, a number of receipts corresponding to the receipt number input by the user.

Furthermore, Abecassis is non analogous art. Where does Abecassis teach or suggest a deposit accepting machine (claim 1)? Where does Abecassis teach or suggest displaying a user image or an item image (claim 1)? Where does Abecassis teach or suggest enabling a user to access a machine interior area to place a deposit item therein (claim 8)?

Neither Peters nor Abecassis, taken alone or in combination, teach or suggest presenting on a display a prompt message for a user to input a receipt number corresponding to a number of receipts to be provided; receiving from a user a receipt number input through an input device

operatively connected to a deposit accepting machine; and providing with a receipt delivery device operatively connected to the deposit accepting machine a number of receipts corresponding to the receipt number input by the user.

The Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Peters with the teaching of Abecassis to have produced the claimed invention.

#### **Claim 19**

Claim 19 depends from claim 18. The Action (page 13, lines 16-17) admits that Peters fails to teach inputting a receipt number corresponding to a number of receipts to be provided, and a printer printing the number of receipts.

As previously discussed (claim 18), neither Peters nor Abecassis, taken alone or in combination, teach or suggest presenting on a display a prompt message for a user to input a receipt number corresponding to a number of receipts to be provided; receiving from a user a receipt number input through an input device operatively connected to a deposit accepting machine; and providing with a receipt delivery device operatively connected to the deposit accepting machine a number of receipts corresponding to the receipt number input by the user.

It follows that neither Peters nor Abecassis, taken alone or in combination, teach or suggest providing with a printer, operatively connected to a deposit accepting machine, a number of receipts corresponding to the receipt number input by the user. Nor has the Office established a *prima facie* showing of obviousness.

**The Pending Claims Are Not Obvious Over  
Peters in view of Tranchita**

Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Tranchita. The rejection is respectfully traversed.

Appellants' remarks involving Peters in support of the patentability of claims 22 and 23 are incorporated by reference as if fully rewritten herein.

**Claim 28**

Claim 28 depends from claim 23. The Action (page 14, lines 7-8) admits that Peters fails to teach that an item image capturing device comprises an infrared camera. Peters does not teach or suggest capturing an image of a deposited item inside a deposit accepting machine (claim 23). Nor does Peters does not teach or suggest displaying an image of the deposited item through a display operatively connected to the deposit accepting machine (claim 22).

Tranchita cannot alleviate the admitted deficiencies in Peters. Tranchita is directed to external surveillance. The external field of view may be illuminated using an infrared laser. Tranchita does not teach or suggest capturing an image of a deposited item inside a deposit accepting machine (claim 23). Nor does Tranchita does not teach or suggest displaying an image of the deposited item through a display operatively connected to the deposit accepting machine (claim 22). It follows that Tranchita does not teach or suggest capturing an image of a deposited item inside a deposit accepting machine with an imaging device comprising an infrared camera.

Thus, neither Peters nor Tranchita, taken alone or in combination, teach or suggest capturing an image of a deposited item inside a deposit accepting machine with an imaging

device comprising an infrared camera. The Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Peters with the teaching of Tranchita to have produced the claimed invention.

#### **Additional Comments**

On page 16, last paragraph, the Action refers to arguments against the references individually. The Appellants respectfully submit that to establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. The Action has not shown how combining references somehow results in a specific recited feature when each of the references individually lacks the specific recited feature. Nevertheless, the Appellants have shown that the references, either taken alone or in combination, do not teach or suggest all of the recited features.

On page 17, first full paragraph, the Action apparently (by inference) admits that Peters' display is not capable of displaying Cataldo's film.

On page 17, second full paragraph, the Action indicates that the Examiner feels that a *prima facie* case has been established. The Appellants respectfully disagree. The Office is reminded of what constitutes a *prima facie* case of obviousness. Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing through objective evidence (not subjective feeling) that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. Furthermore, the teaching, suggestion, or motivation to combine the features in prior art references must be clearly



and particularly identified in such prior art to support a rejection on the basis of obviousness. *In re Dembiczak*, supra. Additionally, even if the Action were to somehow show (which it doesn't) that all of the features recited in the claims were known in the prior art, it would still not be proper to reject the claims on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, supra. *In re Newell*, supra. The Action's attempts to combine the teachings of the references are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. It would not have been obvious to one having ordinary skill in the art to have combined the teachings of the references to have produced the recited invention.

## CONCLUSION

Each of Appellants' pending claims specifically recites steps, features, and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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## APPENDIX

### CLAIMS

1. A method comprising the steps of:
  - (a) capturing a user image of a user with an external area imaging device, wherein the external area imaging device has a field of view including an exterior area outside of a deposit accepting machine;
  - (b) capturing an item image of a deposit item placed inside the deposit accepting machine with an interior area imaging device, wherein the interior area imaging device has a field of view including an interior area inside the deposit accepting machine;
  - (c) displaying the user image and the item image to the user through a display operatively connected to the deposit accepting machine.
2. The method according to claim 1 wherein in step (c) the user image and the item image are simultaneously displayed through the display.

3. The method according to claim 1 and further comprising the step of:

storing the user image and the item image in associated relation in a storage device.

4. The method according to claim 1 wherein the deposit accepting machine includes an access opening, wherein a movable door selectively enables access to the interior area through the access opening, and wherein in step (a) the user image is captured responsive to the user moving the door to a position opening the access opening.

5. The method according to claim 1 wherein the deposit accepting machine includes an access opening to the interior area, wherein the deposit item is passed to the interior area through the access opening, and wherein the deposit accepting machine includes an item transport extending in the interior area, and prior to step (b) further comprising the step of:

moving the deposit item away from the access opening with the item transport to a first internal area wherein the deposit is not accessible through the access opening, and wherein the image of the deposit item in step (b) is captured when the deposit item is in the first internal area.

6. The method according to claim 5 wherein the interior area of the deposit accepting machine further includes a second internal area, wherein the deposit item is stored in the interior area in the second internal area, and subsequent to step (c) further comprising the step of passing the deposit item from the first internal area to the second internal area.

7. The method according to claim 3 wherein the storage device is in operative connection with a server, and further comprising the step of accessing at least one of the item image and the user image from a remote computer through the server.

8. The method according to claim 1 and further comprising the steps of:

receiving a user input from the user through at least one input device in operative connection with the deposit accepting machine;

comparing through operation of a computer, data corresponding to at least a portion of the user input to data stored in a data store for a corresponding relationship;

enabling the user to access the interior area to place the deposit item therein responsive to the input data and stored data having a corresponding relationship.

9. The method according to claim 8 wherein the user input received includes a deposit bag identifier.
10. The method according to claim 8 wherein the input device includes a keypad, and wherein the input received includes a deposit bag identification number input through the keypad.
11. The method according to claim 8 wherein the input device includes a card reader and the input received includes data encoded on a card.
12. The method according to claim 2 wherein the user image and item image are displayed as a single combined image, and further comprising the step of storing the single combined image in a storage device.
13. The method according to claim 8 wherein the user input further includes amount data representative of an amount associated with the deposit item, and wherein in step (c) the amount is displayed through the display with the user image and the item image.
14. The method according to claim 8 wherein the user input further includes data representative of a first amount of a first type item included in the deposit item and a second

amount of a second type item included in the deposit item, and wherein in step (c) the first amount and the second amount are displayed with the user image and the item image.

15. The method according to claim 13 and further comprising the step of storing data representative of the amount, user image and item image in associated relation in a storage device.

16. The method according to claim 15 wherein in the storing step the amount, user image and item image are stored as a single combined image in the storage device.

17. The method according to claim 15 wherein the computer is in operative connection with a clock device, and further comprising recording at least one current time during execution of at least one of the method steps, and wherein in the storing step data representative of the recorded current time is stored in associated relation with the amount, user image and item image.

18. The method according to claim 8 and further comprising the steps of:

presenting on the display a prompt message for a user to input a receipt number corresponding to a number of receipts to be provided;

receiving from a user a receipt number input through an input device operatively connected to the deposit accepting machine;

providing with a receipt delivery device operatively connected to the deposit accepting machine, a number of receipts corresponding to the receipt number input by the user.

19. The method according to claim 18 wherein the receipt delivery device includes a printer, wherein in the providing step the printer is operative to print the number of receipts, wherein each receipt includes indicia corresponding to the amount.

20. The method according to claim 17 wherein the storage device is in operative connection with a server, and further comprising the steps of accessing with a remote computer through the server the associated stored data representative of the recorded time, amount, user image and item image.

21. An apparatus including the deposit accepting machine, external area imaging device, the internal area imaging device, and the display recited in claim 1, operated responsive to a computer to perform the method steps recited in claim 1.

22. A method comprising:

- (a) depositing an item inside a deposit accepting machine;
- (b) displaying an image of the deposited item through a display operatively connected to the deposit accepting machine, wherein a depositor is provided assurance of the deposit.

23. The method according to claim 22 and further comprising capturing an item image of the deposited item inside the deposit accepting machine with an imaging device, and wherein the item image is displayed in (b).

24. The method according to claim 23 and further comprising

capturing a depositor image of a depositor with an imaging device, and

displaying the depositor image through the display.

25. The method according to claim 24 comprising simultaneously displaying the depositor image and the item image through the display.

26. The method according to claim 25 and further comprising



receiving a depositor input through at least one input device in operative connection with the deposit accepting machine, wherein the input includes data associated with the item in (a); and

simultaneously displaying the data, the depositor image, and the item image through the display.

27. The method according to claim 24 wherein the item image capturing device has a field of view including an interior area inside the deposit accepting machine, and wherein the depositor image capturing device has a field of view including an exterior area outside of a deposit accepting machine.

28. The method according to claim 23 wherein the item image capturing device comprises an infrared camera.

29. A method comprising:

- (a) receiving a depositor input through at least one input device in operative connection with a deposit accepting machine, wherein the input includes data associated with a deposit item;

- (b) depositing the deposit item inside the deposit accepting machine;
- (c) displaying the data, a depositor image, and an image of the deposited item through a display operatively connected to the deposit accepting machine.

30. The method according to claim 29 wherein (c) includes simultaneously displaying the data, the depositor image, and the deposited item image through the display.